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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

MAILED
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OFFICE OF PETITIONS

In re Patent No. 6,126,944 :
Issued: October 3, 2000 : REQUEST FOR INFORMATION
Application No.: 08/480,850 :
Filing Date: June 7, 1995 :
Attorney Docket No. 1414.657 :

This is a request for information in response to the petition under 37 CFR 1.137(a) filed May 27, 2011. The petition is properly treated under 37 CFR 1.378(b), to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued October 3, 200. The 7.5 year maintenance fee could have been paid from October 3, 2007, through April 3, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from April 4, 2008, to October 3, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on October 3, 2008.

In summary, petitioner maintains that, after a contract was awarded to new law firms for the tracking and payment of the maintenance fees for the patents held by the assignee, the subject patent file was not routed to the proper place in accordance with assignee's established procedures. More specifically, petitioner states that the established procedure was for all active patent files to be sent by Needle & Rosenberg (the prior law firm) to one of two new law firms awarded the contract, either Klarquist Sparkman or Gifford Krass. All inactive patent files were to be sent back to the assignee. For reasons unbeknownst to petitioner, Needle & Rosenberg sent the patent file for the subject patent back to the assignee. Consequently, no maintenance fee payment schedule was docketed for the subject patent.

Petitioner is required to address the following points:

- Petitioner does not affirmatively identify the cause of the delay in paying the maintenance fee aside from concluding that the 7.5-year maintenance fee payment was not made because the file was erroneously sent back to the assignee, rather than being sent to one of the new law firms. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must

provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. Further, petitioner must provide a statement from persons with knowledge of how Needle & Rosenberg could have sent the active patent file to the assignee rather than to the new law firms. It is noted that petitioner states that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008. Notwithstanding, petitioner should make some effort to obtain a statement from previous employees of Needle & Rosenberg who may have some first-hand knowledge into procedures employed by Needle & Rosenberg for screening the patent files and ensuring they were forwarded to the right place. If petitioner's investigation reveals that a clerical error at Needle & Rosenberg caused file to be misrouted, petitioner is cautioned to adhere to guidance provided in Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner is required to explain what procedures, if any, petitioner had in place for screening the patent files received from Needle & Rosenberg during the transition between law firms.
- Petitioner states that on November 20, 2008, Needle & Rosenberg sent a letter to the assignee forwarding a Notice of Patent Expiration for the subject patent and their electronic summary noting that the subject patent file had been sent to the assignee on September 28, 2008. Petitioner was notified in November 2008, that the subject patent was expired, yet the no petition to

reinstate the patent was filed on May 2011. Petitioner must explain how this delay was unavoidable.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patent
 Mail Stop Petitions
 Box 1450
 Alexandria, VA 22313-1460

By facsimile: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions